ESTTA Tracking number: **ESTTA464823**

Filing date: **04/02/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85149053
Applicant	TA HSING ELECTRIC WIRE & CABLE CO., LTD.
Applied for Mark	DURA PRO POWER
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Submission	Appeal Brief
Attachments	3803-48-APPEALBRIEF-ASFILED-APR02-2012.pdf (25 pages)(213521 bytes)
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Date	04/02/2012

MR3803-48

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant	: Ta Hsing Electric Wire & Cable Co., Ltd.	
Serial No.	: 85/149,053	:
Filed	: 9 October 2010	: Trademark Trial Appeal Board
Mark	: DURA PRO POWER	

BRIEF FOR APPELLANT

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I. INTRODUCTION

Appellant, TA HSING ELECTRIC WIRE & CABLE CO., LTD. appeals the Trademark Examining Attorney's Final Refusal to register the above-identified mark, dated 12 August 2011 and respectfully requests the Trademark Trial and Appeal Board to reverse the Trademark Examining Attorney's decision. It is respectfully requested that all Exhibits and prosecution history of the subject trademark application be considered part of the records in this Appeal.

II. FACTUAL BACKGROUND

Appellant previously filed a trademark application for the mark "DURA POWER" on 22 August 2009 and was granted Serial No. 77/810,641. The goods associated with Serial No. 77/810,641 was for: "extension cables, extension cords, power cables, electric cables, electric cable and wires, connections for electric lines, optical fiber cables, insulated copper electrical wires, junction sleeves for electric cables, electrical plugs and sockets." Appellant's prior trademark application was prosecuted through the U.S. Patent and Trademark Office and Appellant was granted Registration No. 3,874,600 on 9 November 2010.

Appellant filed the subject trademark application, Serial No. 85/149,053 for the mark "DURA PRO POWER" on 9 October 2010. Appellant's Serial No. 85/149,053 is the mark under appeal. Appellant's subject trademark application

claims the identical goods as was issued to Appellant in Appellant's previous Registration No. 3,874,600 which is now in effect.

The Trademark Examining Attorney issued a First Office Action on 20 January 2011 with respect to the subject trademark application and denied registration under Trademark Act Section 2(d) based upon Registration No. 3,006,364 for the mark "DURAPOWER" for the goods of "power supply systems comprising generators and AC and DC bus and breaker panels." Appellant filed a Response and Amendment to the Office Action which disclaimed the word "POWER" apart from the mark as shown and made claim of ownership of Appellant's previous Registration No. 3,874,600. Appellant further argued that reconsideration should be given to Appellant based upon the fact that Appellant is the owner of a previous mark using the words "DURA POWER" for exactly the same goods as the subject application; that the goods of the cited Registration and Appellant's goods are registerably remote each from the other; that there is a differing commercial impression between Appellant's mark and the cited Registration; and that dilution of the common words "DURA" and "POWER" for goods in International Class 9 weigh in the favor of Appellant for issuance of Appellant's mark.

The Trademark Examining Attorney issued a Final Action on 12 August 2011 refusing registration under section 2(d) of the Trademark Act.

Appellant filed a Notice of Appeal on 2 February 2012 with the requisite fee being paid.

This Brief on Appeal is being filed in response to the Final Office Action by the Trademark Examining Attorney.

III. STATEMENT OF THE ISSUES

1. The Trademark Examining Attorney has erred in not giving any registrable weight to Appellant's prior registration for a substantially similar mark with regard to the subject application mark.

2. The Trademark Examining Attorney has erred in a determination that Appellant's goods and the cited Registration goods are sufficiently similar to warrant a denial of registration under Trademark Act section 2(d).

3. The Trademark Examining Attorney has erred in a determination that potential purchasers of Appellant's goods and cited Registration goods would believe that the respective goods would emanate from the same source or presume there is some affiliation between Appellant and the owner of the cited Registration.

4. The Trademark Examining Attorney has erred in not giving registrable weight to third party users of the common portions of the respective marks in question.

5. The Trademark Examining Attorney has erred in determining that Appellant's mark and the cited Registration mark provide for a similar commercial impression as to potential purchasers of the respective goods.

IV. ARGUMENTS

A. Appellant is the Owner of a Similarly Previously Issued Trademark Registration.

The Trademark Examining Attorney erred in not giving registrable weight to Appellant's subject application based upon the fact that Appellant is the owner of Registration No. 3,874,600 for the mark "DURA POWER" which issued on 9 November 2010 even in light of the cited Registration No. 3,006,364 being in full force and effect.

Appellant submits that the subject application and Appellant's previously issued mark are for exactly the same goods, namely: "extension cables, extension cords, power cables, electric cables, electric cable and wires, connections for electric lines, optical fiber cables, insulated copper electrical wires, junction sleeves for electric cables, electrical plugs and sockets."

Appellant submits that Appellant's previous Registration was fully prosecuted before the U.S. Patent and Trademark Office and the cited Registration No. 3,006,364 was not made an issue in Appellant's issued Registration. Appellant relies upon the fact that the U.S. Patent and Trademark Office considered the cited Registration's goods "power supply systems comprising generators and AC and DC bus and breaker panels" to be sufficiently remote from Appellant's goods so as not to lead to any likelihood of confusion between the marks.

Appellant's position is fully supported by the issuance by the U.S. Patent and Trademark Office of Appellant's previous Registration which incorporates the words "DURA" and "POWER." Appellant should be entitled to rely upon the prior positions taken by the U.S. Patent and Trademark Office in the prosecution of the subject application.

Appellant submits that the subject application includes both the words "DURA" and "POWER," however, Appellant has now inserted the word "...PRO..." between the words "DURA" and "POWER." With regard to this matter, Appellant believes that the subject trademark application has still further been removed from the cited Registration mark as shown in Registration No. 3,006,364. With the insertion of the word "PRO," it is believed that Appellant's subject application is further removed from the cited Registration than even Appellant's prior issued Registration for the mark "DURA POWER."

Appellant's previous Registration No. 3,874,600 was fully examined at the U.S. Patent and Trademark Office and was issued on the Principal Register for Appellant's goods. It is not believed by the undersigned attorney that the Trademark Law has been changed or been amended since the prosecution and issuance of Appellant's previous Registration issued on 9 November 2010 to redefine the consideration of "similarity of the goods" in determining a likelihood of confusion between conflicting marks.

It is submitted by the Appellant that if the goods as issued in the cited Registration and the goods in Appellant's previously issued Registration No. 3,874,600 were deemed to be sufficiently remote, each from the other, to warrant the issuance of Appellant's previous Registration at the time that Appellant's previous Registration was being prosecuted at the U.S. Patent and Trademark Office, that the goods at the present time are still sufficiently remote from each other so that Appellant's application mark is entitled to registration independent of which Trademark Examining Attorney is reviewing the application.

B. **Goods of the Cited Registration are Registrably Remote from Appellant's Goods.**

The Trademark Examining Attorney erred in the Final Official Action stating: "Although the Office strives for consistent action, the Examiner cannot ignore and turn a blind-eye to the fact that the marks of the parties are similar and the goods are commercially related."

The Registration cited by the Trademark Examining Attorney has issued in International Class 9 for the goods of: "power supply systems comprising generators and AC and DC bus and breaker panels."

Appellant's subject application is directed to goods in International Class 9 for: "extension cables, extension cords, power cables, electric cables, electric cable and wires, connections for electric lines, optical fiber cables, insulated copper electrical wires, junction sleeves for electric cables, electrical plugs and sockets."

It is respectfully submitted that the only thing Appellant's goods have in common with the cited Registration's goods is that they both are associated with electricity which both Appellant and the cited Registrant share with hundreds of millions of other goods.

The mere fact that a broad class of goods (goods using electricity) may be involved with the cited Registration and the subject application does not support a conclusion that a conflict exists. A trademark owner is given protection against the use of the trademark on any product or service which would reasonably be

thought by the buying public to come from the same source, or is thought to be affiliated with, connected with or sponsored by the trademark owner, however the "goods" must be reasonably thought by the buying public to emanate from the same source which is not the case with regard to the marks in question.

The Trademark Examining Attorney erred in his conclusion that "...the marks of the parties are similar and goods are commercially related." Comparing Appellant's mark with the cited Registration, there is no foundation for suggesting that the buying public would confuse the manufacturer or seller of generators and AC/DC bus breaker panels with a manufacturer and seller of electrical and optical cables.

Both the cited Registration and Appellant's mark are directed to "specialty" items where the products of the respective marks are highly technical and marketed in commercial channels where although there may be some rare overlap, such are definitely sold in different departments, have different categories and are sold to owners who have nothing in common based upon the uses for the respective goods.

The cited Registration's power supply systems would generally be found in specialty establishments directed to purchasers who are highly technical in nature. Whereas Appellant's channels of trade would be in the general merchandise establishments where various types of electrical cables and optical fiber cables are found. Although in some rare instances the respective channels of trade may

overlap, there is no foundation for suggesting that the general channels of trade of Appellant's and the cited Registrant's goods would overlap in any manner and it is not believed that the general channels of trade would be similar. It is believed that there would be no likelihood of confusion between the respective Registration and Appellant's application based upon differing channels of trade between Appellant and the cited Registrant.

The products with which Appellant uses its mark are quite different from the products of the cited Registration. They are different in nature and they are used for different purposes. Additionally, they are promoted differently and they are purchased by different discriminating purchasers.

In the *Quartz Radiation Corp. v. Comm/Scope Company*, 1 USPQ 2d 1668, opposition was made to an applicant's mark "QR" based upon registrations directed to the exact same mark "QR." In that case, the TTAB held that confusion was not likely between the marks since one of the marks was for coaxial cables and the other marks were directed generally to electrical lamps, infrared heaters, ceiling sleeves, transformers, and associated goods. The Board held in that case that "[a]ll of the machines in which opposer's goods are used operate on electricity, as do the television sets or computers with which Applicant's cables are used, but this is as close as the products of the parties get."

Still further, as opposed to the *Quartz Radiation Corp. v. Comm/Scope Company* case, Appellant's mark is not virtually identical to the cited Registration.

There is nothing to substantiate that purchasers of the cited Registrant's goods and Appellant's goods would cause purchasers to mistakenly assume that the goods of Appellant and the cited Registration would share a common source.

C. **Sophistication of Potential Purchasers of Appellant's Goods and Cited Registrant's Goods.**

The Trademark Examining Attorney erred in addressing Appellant's arguments with relation to the sophistication of potential purchasers of Appellant's goods and the cited Registrant's goods. It is believed that the Trademark Examining Attorney alluded to the potential purchasers in determining that the goods of Appellant and the cited Registration are "commercially related" and that "…consumers will undoubtedly retain a similar general recollection of the marks…".

When making a purchasing decision regarding expensive goods, the reasonably prudent person standard of Trademark Law is elevated to the standard of the "discriminating purchaser." See *L. J. Mueller Furnace Co. v. United Conditioning Corp.*, 222 F.2d 755, 106 USPQ 112 (CCPA 1955). Where the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. Thus, confusion is less likely than where the goods are cheap and bought casually. See *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 USPQ 105 (CCPA 1956).

In the present case, the cited Registration's goods are generally directed to power supply systems comprising generators and AC and DC bus and breaker panels. It is believed that such goods are clearly expensive goods and are directed to specialty items where purchasing is not done on the spur of the moment, but

rather is directed to a specific need. Additionally, Appellant's goods are generally directed to electrical and optical cabling items for which the potential purchaser is in particular need. Both of the Appellant's goods and the cited Registration goods are not directed to what would be commonly called off-the-shelf items.

Buyers of such specialized goods would be well versed in the goods being purchased and thus, are given a higher standard of being able to distinguish between the goods when a likelihood of confusion examination is being made.

It is believed that the sophistication and knowledge of the purchasers of Appellant's and Registrant's goods would readily be able to distinguish between Appellant's cables and Registrant's power supply systems and thus, the cited Registration is not believed to lead to any likelihood of confusion with Appellant's mark.

D. **Differing Commercial Impression Between the Cited Registrant's Mark and Appellant's Mark.**

The Trademark Examining Attorney has erred in his conclusion that the commercial impression between the cited Registration and Appellant's mark would have a similar commercial impression. Appellant's mark is directed to the mark "DURA PRO POWER" and the cited Registration is directed to the mark "DURAPOWER." The Trademark Examining Attorney has given an example where he has taken the word "PRO" and made it extremely subservient to the words "DURA" and "POWER" which is not the mark being sought for registration by Appellant. In the Trademark Examining Attorney's rendition of Appellant's mark, the word "PRO" has been reduced to a size which makes it almost unintelligible which does not properly represent Appellant's mark. The Trademark Examining Attorney has also added "Applicant does not dispute this point." However, Appellant does not understand what the Trademark Examining Attorney was referring to with this statement. Appellant does, in fact, dispute the point that there is a differing commercial impression between the marks at issue.

It is appropriate to consider the overall commercial impression of the marks, each taken with respect to the other. With respect to the commercial impression, Appellant's mark is directed to the mark "DURA PRO POWER," whereas, the cited Registration is directed to the mark "DURAPOWER." Both of the marks, although being in standard characters and including no stylization or

design, are directed to specifically different marks. In Appellant's mark, the word "PRO" is between the words "DURA" and "POWER" where the word "PRO" is not relegated to a visually insignificant portion of the mark as is shown by the Trademark Examining Attorney in his example. The cited Registrant uses a compound word as a singular entity, namely, "DURAPOWER."

Additionally, Appellant's mark when using the word "PRO" gives a totally different commercial impression than the cited Registrant's mark and thus is not seen as phonetically obtainable from the cited Registration.

When used as a trademark, it is not believed that there can be any reasonable interpretation of confusion between Appellant's mark and the cited Registration's mark. The dominant portion of Appellant's mark is a visual stylization which gives a totally different impression than that provided by the cited Registration.

The basic rule is that the marks must be compared in their entireties and not dissected, wherein articulating reasons for reaching a conclusion on the issue of confusion, there may be nothing wrong in stating that more or less weight has been given to a particular feature of the mark. However, the ultimate conclusion must rest on the consideration of the marks in their entireties. See *In re National Data Corp.*, 753, F.2d, 1056 (Fed. Cir. 1985).

The Trademark Examining Attorney has erred in improperly dissecting Appellant's mark and comparing only the letters "DURA" and "POWER" when making a comparison with the cited Registration. The Trademark Examining Attorney has dissected Appellant's mark in order to completely ignore the distinguishing elements of Appellant's mark when taken with respect to the cited Registration and has completely ignored the distinctive word "PRO" which is all part of Appellant's commercial impression.

It is well established that a mark should not be dissected, but must be considered as a whole in determining likelihood of confusion. See *MarCon Ltd. v. Avon, Inc.*, 4 USPQ.2d 1474, 1476. This is bolstered by the *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 USPQ.2d 1351, 1354, wherein it stated: "The ultimate conclusion of similarity or dissimilarity of the marks must rest on the consideration of the marks in their entirety." With respect to Appellant's mark, such is directed to a three word mark "DURA PRO POWER" as opposed to the singular word "DURAPOWER" in the cited Registration. The visual impression of both marks is completely different, especially when taken in consideration with the goods of the respective marks and when taken in further consideration that the words "DURA" and "POWER," which are the only common portions of the marks, are highly diluted.

When making a comparison between the marks (in conjunction with the goods being sold), it is believed that the visual, sound and meaning of the cited Registration and Appellant's mark are completely different in appearance, sound and meaning and thus, Appellant' respectfully submits to the TTAB that the Trademark Examining Attorney has erred in his conclusion that the marks would be confusingly similar based upon a similar commercial impression.

E. **Dilution of the Common Portion of Appellant's Mark and the Cited Registration's Mark Preclude a Finding of Likelihood of Confusion.**

The Trademark Examining Attorney erred in his conclusion that the only relevant mark subject to the present analysis belong to Appellant and the cited Registrant and that the combination of the words "DURA" and "POWER" are not diluted and/or weak in relation to the goods of the parties. In fact, the common portions of the marks in question are "DURA" and "POWER." Appellant in an amendment to a First Office Action included a series of marks which included the words "DURA" and "POWER." The Trademark Examining Attorney has noted that Appellant's Exhibit G (in the previous response) was canceled on 19 April 2008. However, it is respectfully submitted to the Board that the Registration No. 3,133,337 for the mark "DURA" (Exhibit D) and Registration No. 2,605,99 (Exhibit F) directed to the mark "DURA-DOME" were issued during the time that Registration No. 2,469,796 directed to "DURA CHARGE" & Design (Exhibit G) was in full force and effect.

Appellant has made the argument that the common portions of the marks at issue ("DURA" and "POWER") are inherently weak and Appellant's use will not give rise to a likelihood of confusion. When common elements of conflicting marks may be words or letters that are weak, this fact reduces the likelihood of

confusion. See *Smith v. Tobacco Byproducts & Chemical Corp.*, 243, F.2d 188 (CCPA 1957).

A portion of a mark or an entire mark may be weak when such portion or full mark is either descriptive, highly suggestive, or is commonly used by many other sellers in the marketplace. The words "DURA" and "POWER" are suggestive of durable power or goods which are electrically operated. The word "DURA" is generally associated in the lexicon with durability and the word "POWER" in many cases (such as the marks at issue) is associated with electrical power. Thus, the words "DURA" and "POWER" are at least highly suggestive of the goods of the cited Registration.

The words "DURA" and "POWER" and variations thereof are commonly used by many other sellers in the marketplace. This is evidenced by a number of third party marks which were registered on the Principal Register which include either the terms "DURA" and/or the word "POWER."

Appellant has provided Exhibits C-L in the Amendment to the First Office Action which clearly shows the concurrent use of the words "DURA" and "POWER" by numerous other parties in the marketplace.

Appellant, under TBMP 1207.03, submits a newly found Trademark Registration where the word "DURAPOWER" is further used by Registration No. 3,502,571 (Exhibit M) attached to this Appeal Brief. Registration No. 3,502,571 is for vacuum cleaners for indoor household purposes. Although this is registered

in International Class 7, it is for vacuum cleaners which also operate on electricity and is for goods which would be deemed closer to the cited Registrant's mark than Appellant's mark.

The concurrent registration of marks which include "POWER" and/or "DURA" for goods relating to electrical products establishes that the U.S. Patent and Trademark Office recognizes that such terms are entitled to a relatively narrow scope of protection and that persons who purchase such goods can readily distinguish between the marks containing such terms without any confusion.

It is thus believed that based upon the dilution of the common words between Appellant's mark and the cited Registration, there would be no likelihood of confusion between the marks.

V. CONCLUSION

The issuance of Appellant's earlier Registration for the mark "DURA POWER," the issuance of many cited Registrations containing "DURA" and/or "POWER", the differences in the goods, the expected channels of trade and the high degree of purchaser care all support Appellant's position that no likelihood of confusion, mistake or deception can be made between Appellant's mark and the cited Registration. Appellant's mark is entitled to registration. Registration merely reflects the concurrent use of the marks in the real world.

The Board is, therefore, respectfully requested to reverse the Trademark Examining Attorney's decision refusing registration of Appellant's mark.

Respectfully submitted,
FOR: TA HSING ELECTRIC WIRE & CABLE CO., LTD.

By: /Morton J. Rosenberg/
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Date: 02 April 2012

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this paper is being transmitted electronically to the U.S. Patent and Trademark Office on the date shown below.

For: ROSENBERG, KLEIN & LEE
/Morton J. Rosenberg/ April 2, 2012
Morton J. Rosenberg Date

Int. Cl.: 7

Prior U.S. Cls.: 13, 19, 21, 23, 31, 34, and 35

United States Patent and Trademark Office

Reg. No. 3,502,571

Registered Sep. 16, 2008

TRADEMARK
PRINCIPAL REGISTER

DURAPOWER

SEARS BRANDS, LLC (ILLINOIS LIMITED LIABILITY COMPANY)
3333 BEVERLY ROAD
HOFFMAN ESTATES, IL 60179

FOR: VACUUM CLEANERS FOR INDOOR HOUSEHOLD PURPOSES, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34 AND 35).

FIRST USE 11-0-2007; IN COMMERCE 11-0-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-185,953, FILED 5-21-2007.

KIMBERLY PERRY, EXAMINING ATTORNEY

Exhibit M